

REMARKS

Applicant has carefully studied the Office Action of 26 September 2003 and offers the following remarks in response thereto.

Initially, Applicant appreciates the indication that claims 22-26 include allowable subject matter. Applicant herein amends claim 22 to include the subject matter of the underlying independent claim. Claims 22-26 should now be in condition for allowance. Applicant encloses a credit card form to cover the cost of the additional independent claim created by this amendment.

Claims 1, 2, 4, 8-11, 13, 19, and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Salama et al. Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is located in the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

Claim 1 recites an interworking agent that operates according to a third protocol. The Patent Office indicates that there is a translation means for performing translation between H.323 protocol and SIP and that it is inherent that the translation is performed based on a set of predetermined rules which the Patent Office indicates is the same as the recited third protocol. Applicant traverses this construction of the claim element. While the Patent Office is entitled to give claim elements a broad reasonable interpretation, this interpretation is determined from the point of view of someone of ordinary skill in the art. MPEP § 2111. Someone of ordinary skill in the art, after reading page 13, line 1-page 14, line 11 (which discuss the interworking agent and the third protocol), would not consider a set of predetermined rules to perform the translation to be a protocol. To this extent, an element is not shown, and the reference does not anticipate the claim.

Furthermore, even if such a translation rule set was a third protocol, claim 1 recites that the third protocol is a superset of functions provided by the first and second IP telephony protocols. The Patent Office never addresses where in the reference this claim element can be found. For an element to be inherent, the element must necessarily be present in the reference. MPEP § 2112. A rule set to govern translation does not necessarily have to be a superset of the functions provided by the first and second IP telephony protocols. To this extent, an element is not shown and the claim is not anticipated.

Claims 2, 4, and 8-10 depend from claim 1 and are not anticipated for at least the same reasons.

Claim 11 recites three protocols in which the first message is received in the first protocol, which causes the second message in the second protocol to be generated and sent to a second protocol agent, which upon receiving the second message generates a third message in a third protocol. The Patent Office indicates that the call received from the PX1 by the PX2 is the first message; the call received at the GW1 is the second message, and the call received at the PX3 is the third message. However, the Patent Office does not provide any indication of which PX1, PX2, GW1, or PX3 is being discussed. Applicant notes that there are at least 4 PX1s (1434, 1634, 1834, and 1934) and multiple PX2s (1646, 1446, 1838, 1946), not all of which receive signals from the PX1. Applicant requests clarification as to which PX1, PX2, PX3 and GW1 are being discussed, as this is not clear from the Patent Office's analysis. Applicant has reviewed the reference and does not find any evidence of the three recited protocols. As such, Applicant respectfully requests that this rejection be withdrawn. If the Patent Office disagrees, Applicant requests the Patent Office to indicate with greater particularity what the Patent Office intended in this rejection so that it may be addressed. Without a better explanation, the rejection fails to show the claimed elements and the claim is not anticipated.

Claims 13, 19, and 20 depend from claim 11 and are patentable for at least the same reasons.

Claims 1 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by 'An Architecture for Residential Internet Telephony Service' written by Huitema et al. Applicant notes that the article is not available under § 102(e). § 102(e) refers to a published patent application or a granted patent. Huitema et al. is neither. Since the reference is not available under § 102(e), a rejection thereunder is improper. Applicant requests withdrawal of the § 102(e) rejection of claims 1 and 6 at this time.

Claims 5, 7, 14, 21, 27-30, 32, and 33 were rejected under 35 U.S.C. § 103 as being unpatentable over Salama et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the references. MPEP § 2143.03.

Claims 5 and 7 depend from claim 1. To the extent that Salama et al. does not show all the elements of claim 1, claims 5 and 7 likewise have elements which are not shown. Since the

reference does not show all the claim elements nor suggest the claim elements, the claims are not obvious over Salama et al.

Claim 14 depends from claim 11. To the extent that Salama et al. does not show all the elements of claim 11, claim 14 likewise has elements which are not shown. Since the reference does not show all the claim elements nor suggest the claim elements, the claim is not obvious over Salama et al.

Claim 21 recites that the first message is transmitted without alteration. The Patent Office admits that this element is not taught by Salama et al., but opines that it would have been obvious to modify the reference to do this. Applicant respectfully traverses. For the Patent Office to modify a reference, the Patent Office must present objective evidence of the motivation to modify the reference. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office has presented no evidence as to why this modification would have been obvious to one of ordinary skill in the art and thus, the modification proposed by the Patent Office is not supported. Since the modification is not supported, the Patent Office admittedly has not shown a claim element and has not established *prima facie* obviousness.

Claim 27 recites the third protocol. As explained above, Salama et al. does not teach or suggest this claim element and thus, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, the claim is allowable over the rejection of record.

Claims 28-30, 32, and 33 depend from claim 27 and are patentable at least for the same reasons.

Claims 3, 12, 15-18 and 31 were rejected under 35 U.S.C. § 103 as being unpatentable over Salama et al. in view of Huitema et al. Applicant respectfully traverses. As explained above, Salama et al. does not show all the elements for the underlying independent claims. Nothing in Huitema et al. cures this deficiency. Since the references individually do not teach or suggest all the claim elements, the combination of references cannot teach or suggest the claim elements. Since the claim elements are not taught or suggested, the Patent Office has not established *prima facie* obviousness and the claims are allowable.

Applicant tried to schedule a telephonic interview prior to filing of the present response, but the Examiner indicated that the file had to be ordered. As of the writing of this response, the Examiner had not received the file and was unable to schedule the telephonic interview.

Applicant files the present response without the benefit of the interview to file a timely response before the three month date. In the event that an interview can be scheduled, Applicant will file a supplemental response as needed to address the issues raised in the interview.

Applicant requests reconsideration of the rejection in light of the arguments presented herein. Specifically, the references of record do not teach or suggest the third protocol as that term is used in the specification and claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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